

## REMARKS

In the Office Action mailed, March 1, 2005 ("Office Action"), the Examiner rejected claims 1-15. This reply amends claims 1 and 8-15 and adds new claims 16 and 17. Thus, claims 1-17 are pending and under consideration.

### **I. Response to § 103(a) rejection**

The Examiner rejected claims 1-15 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,327,578 ("Linehan"). The Applicants respectfully traverse this rejection. The rejection is improper because Linehan does not teach or suggest all the limitation of the claims and because the Examiner failed to provide a proper motivation for modifying Linehan.

#### **A. Failure to teach all limitations**

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

MPEP § 2143.03.

Claim 1 recites security information comprising "information regarding a design error or bug in a computer program." Linehan does not teach or suggest this feature. Instead, Linehan teaches a method of transacting business electronically between a customer, a merchant, an issuer of a credit card, and a bank. See Linehan, col. 3, l. 66 through col. 4, l. 57. Nowhere does Linehan teach anything comparable to "information regarding a design error or bug in a computer program." As Linehan does not teach or suggest all the features of claim 1, the claim is allowable over Linehan.

Claims 8 and 15 are allowable over Linehan for at least the same reason claim 1 is allowable over Linehan. Claims 2-7 and 9-14 depend upon claims 1 and 8 respectively. Thus, claims 2-7 and 9-14 are allowable for at least the same reason claims 1 and 8 are allowable.

#### **B. No motivation to modify**

To establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

MPEP § 2143.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

MPEP § 2143.01.

The Examiners rejection is also improper because the Examiner failed to provide a proper motivation to modify Linehan. According to the Examiner, any modification "would be a routine skill in the art and not a patentable invention but rather a design choice." Office Action, p. 4, ll. 12-14. The Examiner also asserts that one skilled in the art would have modified Linehan "to fit their design need." *Id.* Neither of these assertions constitute a reason to modify Linehan. If the Examiner continues to assert that one would modify "to fit their design need," the Applicants request the Examiner to articulate such a design need and to provide a reason why one would modify Linehan.

Furthermore, even if the motivation provided by the Examiner was proper, the Examiner failed to explain the source of the motivation. As the Examiner can not articulate a source for the motivation, it appears that the Examiner is applying improper hindsight reasoning by relying on teachings in the application's specification.

## **II. New claims 16 and 17**

This reply adds claim 16. Claim 16 is allowable over Linehan at least the same reason claim 1 is allowable over Linehan. Claim 17 emphasizes a user detecting a valuable security flaw and being rewarded for reporting it. The prior art does not teach or suggest such.

## **III. Conclusion**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.


Serial No. 09/739,645

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 6/1/8

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